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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/412,558

10/05/99

HWANG

J

08919/022001

EXAMINER

HM12/0821

DEVI, S

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

08/21/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/412,558

Applicant(s)

Hwang et al.

Examiner

S. Devi, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 31, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 ~~is/are~~ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Restriction / Election

- 1) Claims 1-23 are under prosecution.
- 2) Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your election responses. The Fax number is 703-305-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
- 3) Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2-5, drawn to a polypeptide comprising a gonadotropin releasing hormone, classified in class 530, subclass 350.
 - II. Claims 6-9, drawn to a polypeptide comprising a fragment of a vaccinia virus coat protein, classified in class 530, subclass 350.
 - III. Claim 15, drawn to a nucleic acid encoding a polypeptide comprising a gonadotropin releasing hormone, classified in class 536, subclass 23.1.
 - IV. Claim 16, drawn to a nucleic acid encoding a polypeptide comprising a fragment of a vaccinia virus coat protein, classified in class 536, subclass 23.1.
 - V. Claim 20, drawn to a method of producing a polypeptide by expressing in a cell a nucleic acid encoding a polypeptide comprising a gonadotropin releasing hormone, classified in class 935, subclass 71.1.
 - VI. Claim 21, drawn to a method of producing a polypeptide by expressing in a cell a nucleic acid encoding a polypeptide comprising a fragment of a vaccinia virus coat protein, classified in class 935, subclass 71.1.

Claims 1 and 10-13 are considered as linking claims and would be joined with one of inventions I and II, if elected.

Claims 14, 17 and 18 are considered as linking claims and would be joined with one of inventions III and IV, if elected.

Claims 19, 22 and 23 are considered as linking claims and would be joined with one of inventions V and VI, if elected.

4) Inventions I through VI are distinct from one another. Inventions I, II, III and IV are drawn to distinct products: polypeptides and nucleic acids. The polypeptides of inventions I and II and the nucleic acids of inventions III and IV are distinct from one another structurally, physicochemically, functionally, immunologically and/or biologically and thus require different searches. Inventions V and VI are drawn to methods of making two distinct polypeptides.

5) Inventions III and V and inventions IV and VI are related as products and processes of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the nucleic acids of invention III and IV can be used in a materially different process, for example, as immunogens to raise DNA-specific antibodies, or as sources of coating antigens in an *in vitro* diagnostic assay.

6) Inventions I and V and inventions II and VI are related as products made and process of making the product. The inventions are distinct if either or both of the following can be shown: (1) that the processes as claimed can be used to make other and materially different products or (2) that the products as claimed can be made by another and materially different processes (MPEP 806.05(f)). In the instant case, the polypeptide products of invention I and II can be made by a process materially different from the process of inventions V and VI, i.e., without using the corresponding nucleotide acids, for example, by chemical synthesis.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification/subclassification and divergent subject matter, and since a search performed for one would not be co-extensive for the other, restriction for examination purposes as indicated is proper.

7) Applicants are advised that the response to this requirement to be complete must include

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an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

8) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

9) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. The Examiner can normally be reached on Monday to Friday from 7.45 a.m. to 4.15 p.m. A telephone message may be left on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


S. Devi, Ph.D.
Primary Examiner
August 2001